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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/186,064	11/04/1998	THOMAS N. TOOMBS	HARI.127US0	1357

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EXAMINER

MYERS, PAUL R

ART UNIT PAPER NUMBER

2189

DATE MAILED: 05/27/2003

35

Please find below and/or attached an Office communication concerning this application or proceeding.

SL

**Office Action Summary**

Application No.

09/186,064

Applicant(s)

TOOMBS ET AL.

Examiner

Paul R. Myers

Art Unit

2189

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 87-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 87-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 87-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima PN 5,349,649 in view of MacKenna et al PN 5,495,594.

In regards to claim 87, 91-92 and 97: Iijima teaches a host (7) that operates in a first protocol; and a card (1) connectable to the host (7) for transferring data (data) and commands (command) between the card (1) and the host (7), wherein the card (1) is capable of operating in a plurality of communication protocols (Protocol A or Protocol B) including a first protocol (either A or B) and wherein the first protocol is selected in response to initialization (Reset) when connected to the host (7). Iijima teaches the card selecting the protocol based upon the masters informing it of which protocol to use. Iijima does not teach the card selecting the communication protocol without the master informing it which protocol to use. MacKenna et al teaches a peripheral configuring itself to use the protocol used by the host based solely on the signals present during an initial reset from the host. It would have been obvious to a person of ordinary skill in the art at the time of the invention for the memory card to select the protocol to use based upon the detected protocol of the master because this would have provided for backwards compatibility with older masters.

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In regards to claims 88 and 93: MacKenna et al teaches the initial reset command including first connection pins that in the first protocol are not asserted and in the other protocol are asserted (Signals RD\* WR\* R/W DS\* Figures 5A-6B).

In regards to claims 89-90, 94-95, 98-101: Iijima et al teaches a plurality of protocols. Iijima et al does not teach which specific protocols are supported. Official notice is taken that both the MultiMediaCard protocol and the Serial Peripheral Interface protocols are well known standard protocols. It would have been obvious to a person of ordinary skill in the art at the time of the invention to support these protocols because this would have made Iijima et al's card compliant to both these standards.

In regards to claim 96: Iijima et al teaches multiple cards.

In regards to claims 102-103: Iijima et al does not teach placing the memory card in another host. Iijima et al does teach the method claimed of determining the communication protocol. Official notice is taken that using memory cards to transfer data from one host to another such as for example from a digital camera to a personal computer is well known in the art. It would have been obvious to couple Iijima et al's memory card to another host because this would have allowed for the transferring of data.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 703 305 9656. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703 305 4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746 7239 for regular communications and 703 746 7239 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.



PAUL R. MYERS  
PRIMARY EXAMINER

PRM  
May 22, 2003